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PATENT APPLN. NO. 10/535,186
RESPONSE UNDER 37 C.F.R. §1.111

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REMARKS

For convenience, the headings used in the Office Action will be used in the present response.

Election/Restrictions

The Office is requiring confirmation of the provisional election of claims 1-8¹ for prosecution in this application.

Applicants confirm the election of claims 1-8 with traverse. The present application is the national stage of PCT/FI2003/000880. Therefore, unity of invention practice and not restriction practice must be applied to the claims of the present application. In the present application, the Office has applied restriction practice. Unless or, at least, until the Office applies unity of invention practice under 37 C.F.R. 1.399 and according to the requirements of MPEP 1893.03(d), the restriction requirement is improper and removal of the requirement is in order.

Specification

The Office has objected to various informalities in the specification. However, the informalities identified by the Office were corrected in a Preliminary Amendment filed May 27, 2005. The

¹ The Action identifies restriction between I) claims 1 to 7 and II) claims 8 to 13. However, claim 8, which is dependent on claim 1 and directed to a method, should be included with the Group I claims, as it was in the initial telephone restriction requirement.

Preliminary Amendment is available through the Image File Wrapper of the present application. The Office has not provided reasons for non-entry of the amendment and entry is otherwise believed to be proper.

Claim Rejections - 35 USC § 112

Claims 1-7 [sic, 1-8] are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Generally, the claims have been amended to provide consistency in claim terminology and to ensure proper antecedent basis for the claim terminology. The following specific amendments are noted.

The Office states that the limitation "the following refiner" renders claim 1 indefinite. The recitation has been amended to -- the second refining stage--.

The Office also states that the limitation "the previous stage and the following stage" in claim 5 lacks sufficient antecedent basis. Claim 5 has been canceled.

The terminology "the comparable processes" has been deleted from claim 3.

Removal of the 35 U.S.C. 112 rejections of the claims is believed to be in order and is respectfully requested.

Claim Rejections - 35 USC § 103

Claims 1-7 [sic, 1-8] are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being obvious over Cederquist et al. (U.S. Patent No. 4,136,831) (hereinafter: "Cederquist") in view of WO 96/18769 (hereinafter: "WO '769"). Claims 1-7 [sic, 1-8] are also rejected under 35 U.S.C. 103(a) as being unpatentable over WO '769 in view of Cederquist.

Prior to discussing the insufficiencies of Cederquist and WO '769 to support the rejections made in the Action, applicant notes that claim 1 has been amended to precisely recite that in the method of the present invention, at least two refining stages are provided, each refining stage including a rotor and a stator. This amendment is supported in the specification, inter alia, in the paragraph bridging pages 3 and 4, and the description of the drawing on pages 5 and 6.

Referring to the rejection for anticipation under 35 U.S.C. § 102(b) over Cederquist and the alternative rejection for obviousness under 35 U.S.C. § 103(a) over Cederquist in view of WO '769, Cederquist is identified by the Office as disclosing a method for producing fibers from wood chips which meets the limitations of the claims including, inter alia, "using at least two refining stages" (Action, page 6, line 8 from the bottom of the page)

comprising "feeding at least wood chips and water into a first refining stage [defibrator 6]" (Action, page 6, lines 6-5 from the bottom of the page). Cederquist is further alleged to disclose "feeding the flow of mixture of fibers that are refined and steam forward at least in the first refining stage by rotary energy of a rotor of the refiner" (Action, page 6, last line, to page 7, line 1).

The Office's characterization of the disclosure of Cederquist is wrong. Numeral "6" in the drawing of Cederquist is identified in the specification as "defibrator preheater 6" (Col. 3, line 2). Defibrator preheater 6 is not a first refining stage, but, instead, is simply a preheater for preheating the chips fed to "defibrator 8" (Col. 3, line 10, of Cederquist).

Defibrator preheater 6 of Cederquist cannot be characterized as a refining stage because the wood chips are merely preheated therein and are not subjected to mechanical forces for separating fibers from the wood chips. It is clearly understood by a person of ordinary skill in the paper or pulp industry that refining is a stage wherein the fibers of a raw material are separated from each other using mechanical force. In Cederquist there is only one refining stage comprising defibrator 8.

Cederquist, therefore, does not disclose each limitation, or element, of the method recited in claim 1 and cannot support a case of anticipation under 35 U.S.C. § 102 of claims 1-8.

The Office notes in the Action that, if Cederquist does not disclose a first refining stage comprising a rotor, then WO '769 teaches the desirability of utilizing rotors for preparing pulp. The Office takes the position that it would have been obvious in view of WO '769 to "replace the refiner in the device of Cederquist with the rotor as taught by WO '769." (Action, page 7, lines 11-12).

Applicant respectfully submits that the proposed modification of the device of Cederquist is improper because defibrator preheater 6 (which, presumably, is the "refiner" referred to by the Office) of Cederquist is not a refining stage. A person of ordinary skill in the art would have no motive to either use a rotor in the preheater of Cederquist or to replace the preheater of Cederquist with a refining stage including a rotor.

Referring to the rejection of the claims for obviousness over WO '769 in view of Cederquist, WO '769 is cited as disclosing each of the limitations, or elements, of the rejected claims with the exception of feeding the flow of fibers and steam through a flow path having a cross section that is constant or decreasing between

at least the exit of the first refining stage and infeed of the second refining stage and of separating steam from the fibers after the second refining stage and feeding at least part of that steam back to the first refining stage. Cederquist is cited as disclosing the desirability of separating steam from the fibers after the second refiner and feeding that steam back to the first refiner. In light of this characterization of the disclosure of Cederquist, it is the position of the Office that it would have been obvious to modify the device of WO '769 so that separated steam can be fed back to the first refiner.

Applicant respectfully submits that the Office has not properly supported a *prima facie* case of obviousness of claims 1-8 under 35 U.S.C. § 103(a) over WO '769 in view of Cederquist because, as explained above, Cederquist does not disclose a process that includes first and second refiners. Therefore, the characterization of Cederquist as disclosing the desirability of separating steam from the fibers after the second refiner and feeding that steam back to the first refiner is not correct and cannot support, in combination with WO '769, a *prima facie* case of obviousness of the claims of the present application.

It is also noted that the proposed modification of the process of WO '769 will not necessarily result in the method claimed in the

present application because, contrary to the allegations in the Action, WO '769 is completely silent concerning how the pulp and steam flow is transferred from the first refiner to the second refiner. There is no indication of whether or not the steam is separated and also no disclosure concerning the cross section of the feeding line. Finally, applicant notes that the Office cannot properly rely on the drawing of Cederquist as teaching that it is conventional to use pipes having a constant cross section for transfer of material because there is no indication in Cederquist that the drawings are drawn to scale or otherwise accurately depict the scale and dimensions of the components of the apparatus used in the process disclosed therein.

Removal of the rejections of the claims is believed to be in order and is respectfully requested.

The foregoing is believed to be a complete and proper response to the Office Action dated July 3, 2006, and is believed to place this application in condition for allowance. If, however, minor issues remain that can be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number indicated below.

In the event that this paper is not considered to be timely filed, applicant hereby petitions for an appropriate extension of

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time. The fee for any such extension may be charged to our Deposit Account No. 111833.

In the event any additional fees are required, please also charge our Deposit Account No. 111833.

Respectfully submitted,

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